

REMARKS

All pending claims in the present application have been rejected under 35 U.S.C. §103(a) in the Office Action of April 17, 2006 (the Office Action). The specific grounds and combinations of references supporting the rejections are discussed in detail below. For the reasons specified herein, applicant respectfully traverses the rejections, requests reconsideration of the claims, and timely allowance of this application.

Claims 1-6, 9-14, 17-24, 27-33, 36-41, 44-51, and 54

Claims 1-6, 9-14, 17-24, 27-33, 36-41, 44-51, and 54 were rejected in the Office Action as being unpatentable over USP 6,564,261 (Gudjonsson) in view of USP 5,793,365 (Tang) and further in view of USP 6,020,915 (Bruno). The traverse of the rejection of these claims is based on the failure of the references to disclose, teach or suggest a device for or method of establishing a video conference in response to a request for same by an instant messaging server, and the absence of any suggestion for how the teachings of the references may be combined to obtain such a limitation.

Initially, it is noted that the Office Action appears to make the argument that applicant's invention is merely the combination of two client nodes, a video server, an instant messaging server, and a video conference resource allocator. However, as will be pointed out, the present invention involves much more than this mere collection of parts. In one embodiment, the present invention is a system which permits the allocation of video conference resources based upon the interpretation of an instant message from one

of the two nodes. That is, the instant message server and the video conference resource allocator are designed to work together to enable the initiation of a video conference by the instant messaging server. This is not a function provided by the mere combination of known parts.

As explained in applicant's prior response, claim 1 of the present application includes the limitation:

a video conference resource allocator, communicatively coupled to said instant messaging server and said second server, said video conference resource allocator adapted to allocate video conference resources in said second server in response to a request for a video conference from said instant messaging server, such that a video conference may be initiated between the at least two client nodes, and further adapted to communicate to the at least two client nodes, via said instant message server, resource information enabling the at least two client nodes to join the video conference.

Claim 1, lines 9-15 (emphasis added), where the aforementioned second server might typically be a video server. See also the nearly identical language in claim 28, lines 9-15. This is one of the features which provide the ability to establish a video conference using an instant messaging utility.

While Gudjonsson teaches a network management system capable of establishing communication sessions between users, it does not disclose or suggest an IM server configured to initiate a video conference in response to an instant message

communication sent by a user. The reference does not teach or suggest "a video conference resource allocator adapted to allocate video conference resources ... in response to a request for a video conference from said instant messaging server." Furthermore, the cited section of Gudjonsson (col. 7, lines 42-51) does not teach or suggest that "at least two client nodes [communicate], via said instant message server, resource information enabling the at least two client nodes to join [a] video conference." That is, contrary to the statement in the Office Action, the cited section of Gudjonsson does not teach or suggest that two client nodes communicate "via said instant message server, resource information enabling the at least two client nodes to join the video conference." And overall, as acknowledged in the Office Action, Gudjonsson does not teach an instant message server capable of causing the initiation of a video conference by way of instant messaging.

Tang teaches a user interface for collaborative work which provides users with a "chat room" feature. Whether or not communications within a chat room are "instant messages", Tang makes no mention of the ability to launch any service, particularly a video conference, using a communication uniquely within a chat room. Again, the reference does not teach or suggest "a video conference resource allocator adapted to allocate video conference resources ... in response to a request for a video conference from said instant messaging server." Therefore, Tang also fails to teach or suggest an instant message server capable of causing the initiation of a video conference by way of instant messaging.

The Office Action states that it would have been obvious to one of ordinary skill in the art to modify the teachings of Gudjonsson to use a chat server to provide text communication between users. First, this is merely a conclusion, with no supporting rationale for making the modification. There is nothing in either reference to motivate combining their teaching to arrive at this feature. In establishing a case of *prima facie* obviousness, the cited references must specifically disclose a reason or motivation to combine their teachings to make the claimed invention. In re Dillon, 919 F.2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)(en banc), cert denied, 500 U.S. 904 (1991). As applicant has previously pointed out, no such reason or motivation is cited on the Office Action nor in fact present in the references. Second, even if the combination of references were permissible, the combination would still fail to teach or suggest key limitations of the presently claimed invention, including "a video conference resource allocator adapted to allocate video conference resources ... in response to a request for a video conference from said instant messaging server."

The Office Action cites Bruno for its teaching of a video conference resource allocator. Bruno teaches a system for including a user of a Plain Old Telephone System (POTS) devices (e.g., a standard telephone handset and fax machine) in a video conference, despite the lack of a proper protocol on the POTS devices. There is no mention in Bruno of the use of instant messaging, chat, or similar non-video, non-image, and non-voice communications for any purpose. Initiation of video conferences are handled by Bruno in a fairly tradition manner, via a resource allocator referred to as a MRCS, for example by calling the resource provider, or by a direct communication between two multimedia-enabled workstations (see col. 4, line 67, to col. 5, line 16).

There is no mention or suggestion in Bruno of any mechanism for initiating a video conference via any sort of messaging service, and therefore Bruno cannot add to Gudjonsson or Tang that which those references are lacking in terms of the present invention, namely "a video conference resource allocator adapted to allocate video conference resources ... in response to a request for a video conference from said instant messaging server."

Indeed, even making the combination of Bruno with either of Gudjonsson or Tang (let alone both) is improper. Bruno makes no mention whatsoever of use of a video conference service with any sort of messaging service. There is absolutely no suggestion in Bruno to use its POTS device with a conference initiation system (such as in Gudjonsson) or a chat system (such as in Tang). Combining or modifying the teachings of the prior art as evidence that the claimed invention is obvious is proper only "where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992)." M.P.E.P. § 2143.01. The burden is on the Examiner to explain how the prior art suggests and motivates the proposed combination so as to render obvious the claimed invention. Ex parte Levy, 17 U.S.P.Q.2d 1461 (BPAI 1990). Yet, the Office Action cites no suggestion or motivation to combine the various teachings of the references. The mere fact that Bruno teaches a resource allocator for a video conference as cited in the Office Action does not, by itself, provide motivation to modify an instant messaging server and resource allocator such that the instant messaging server can cause initiation of a video conference. Accordingly, the proposed combination of

Gudjonsson, Tang, and Bruno is improper in terms of using such a combination to show obviousness of applicant's claimed invention.

Neither Gudonsson, Tang, nor Bruno, nor the combination of these three (assuming such a combination were even permissible) teach a system in which a video conference may be initiated by an instant messaging service. In terms of the claims, it is therefore evident that there is no teaching or suggestion of "a video conference resource allocator adapted to allocate video conference resources ... in response to a request for a video conference from said instant messaging server." Accordingly, claims 1 and 28 are patentably distinct from these cited references. Likewise, since claims 2-6, 9-14, 17-24, and 27 depend directly or indirectly from claim 1, and claims 29-33, 36-41, 44-51, and 54 depend directly or indirectly from claim 28, these claims contain all limitations of their respective independent base claims, and are patentably distinct from the cited references by the same rationale. Accordingly, applicant respectfully traverses the rejections of claims 1-6, 9-14, 17-24, 27-33, 36-41, 44-51, and 54, and requests their reconsideration and allowance.

Claims 7, 8, 15-16, 25-26, 34-35, 42-43, and 52-53

Claims 7, 8, 15-16, 25-26, 34-35, 42-43, and 52-53 were rejected in the Office Action as being unpatentable over Gudjonsson in view of Tang and Bruno, and further in view of USP 6,640,239 (Gidwani). Just as with the previously discussed group of claims, the traverse of the rejection of these claims is based on the failure of the references to disclose, teach or suggest a system for or method of establishing a video conference in

response to a request for same by an instant messaging server, and the absence of any suggestion for how the teachings of the references may be combined to obtain such a limitation.

As applicant explained in its prior response, Gidwani discloses the configuration of a network switching architecture. It discloses no details of instant messaging or video conferencing. It does not even allude to the difficulties of launching one type of communication service (i.e., video conferencing) using messaging from another type of communication service (i.e., instant messaging). From the above, it is clear that the Gudjonsson, Tang, and Bruno references taken alone or in combination (albeit an improper combination) fail to teach or suggest "a video conference resource allocator adapted to allocate video conference resources ... in response to a request for a video conference from said instant messaging server" (claim 1, lines 9-15, and nearly identical language in claim 28, lines, 9-15). Gidwani clearly fails to teach this limitation as well. And, it fails to provide any motivation to modify the teachings of Gudjonsson, Tang, or Bruno, or these three in combination, to arrive at such a limitation.

Once again, the Office Action makes no reference to a motivation or suggestion to modify the teachings of Gudjonsson, Tang, and Bruno. True or not that "Gidwani teaches using ISDN and ATM [standard] protocol," this statement provides no suggestion to combine or modify the teachings of other references. Thus, the statement that "it would have been obvious to one (sic) ordinary skill in the art at the time of the invention to modify the teachings of Gudjonsson in view of Tang in further view of Bruno to use ISDN and ATM standard protocol as taught by (sic) Gidwani in order to use different protocol

for communication" is merely an unsupported conclusion. Ex parte Garrett, 1986 Pat. App. LEXIS 8, 4 (EPAI 1986). Clearly, the legal burden upon the Patent Office to show motivation for making modifications and combinations of references (In re Rouffet, 149 f.3d 1350, 1357 (Fed. Cir. 1998)) has not been met.

Therefore, Gidwani fails to overcome the aforementioned shortfalls of Gudjonsson, Tang, and Bruno in terms of establishing a *prima facie* case of obviousness of claims 1 and 28, as well as the claims depending from claims 1 and 28. As claims 7, 8, 15, 16, 25, and 26 depend directly or indirectly from claim 1 and claims 34, 35, 42, 43, 52, and 53 depend directly or indirectly from claim 28, they contain all of the limitations of claims 1 and 28, respectively. Thus, no *prima facie* case of obviousness of those claims has been made, and accordingly those claims are patentably distinct from the cited references for at least the reasons enumerated above with regard to claims 1 and 28. Accordingly, applicant respectfully traverses the rejections of claims 7, 8, 15, 16, 25, 26, 34, 35, 42, 43, 52, and 53, and requests their reconsideration and allowance.

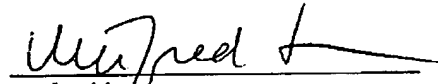
CONCLUSION

Applicant's invention, as defined by the scope of the claims of the present application, is more than a mere collection of known parts. Various elements are assembled, and special adaptation is made, to produce a result heretofore unavailable – the ability to initiate a video conference from within an instant messaging application. None of the cited references identify a need for such a result let alone means for accomplishing it.

In view of the foregoing, applicant believes all claims pending in this application distinguish over the cited art, taken alone or in combination, and are in condition for allowance. The issuance of a formal Notice of Allowance of this application at the earliest possible date is respectfully requested.

If the Examiner believes that a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-969-8300.

Respectfully submitted,



Wilfred Lam
Attorney for Applicant
Registration No. 41,923
Telephone: 650-969-8300

P.O. Box 1169
Los Altos, California 94023-1169
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